

Appln No. 09/944,348
Amdt date February 12, 2007
Reply to Office action of August 10, 2006

REMARKS/ARGUMENTS

Claims 29-82 were pending in the application. After amendment claims 29-88 are now pending. In the Office action mailed August 10, 2006, the drawings were objected to, the claims were rejected for non-statutory double patenting, and the claims were rejected under 35 U.S.C. § 103(a). The Examiner is thanked for attention to the application.

The drawings are indicated as accepted for correct labeling, but the Office action also indicates that new corrected drawings are required because the drawings are done in free-hand without the use of a straight edge. A review of the drawings filed for the application, as well as the drawings available in the PTO PAIR system, indicates that the drawings on file with the PTO for the application are computer generated drawings. Accordingly, it appears that the Office action may reflect inadvertent reference to informal drawings previously submitted in the case. Nevertheless, a complete set of the computer generated figures in the application are provided herewith.

The claims are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over various claims of the patent issuing from the parent application, U.S. Patent No. 6,286,140, in combination with other items are prior art.

An obviousness-type double patenting rejection can be overcome by the filing of the Terminal Disclaimer. As indicated in the response to the prior Office action, as the claims are also rejected under 35 U.S.C. §103, a Terminal Disclaimer at this stage of the proceedings is premature. Accordingly, it is respectfully requested that the obviousness-type double patenting rejections be held in abeyance until Applicant is provided an indication of allowable subject matter.

It is noted that with respect to the double patenting rejection the Office action states "The obvious-type Double-Patenting Rejection will not be withheld until the filing of a Terminal Disclaimer." Office action, p. 3. The meaning of this statement is not clear to Applicant, although it appears to indicate that upon the filing of a Terminal Disclaimer the Office will withhold making an obviousness-type double patenting rejection. In the event that some other meaning was meant by this statement, Applicant respectfully notes that absent an indication of

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otherwise allowable subject matter it is entirely possible that the claims will be changed in such a manner to no longer be the subject of double patenting rejection, and "the filing and recordation of an unnecessary Terminal Disclaimer has been characterized as an 'unhappy circumstance' *In re Jentoft*, 392 F.2d. 633, 157 USPQ 363 (CCPA 1968)." MPEP §1490 VII A. It is also noted that nullification of a recorded Terminal Disclaimer may be addressed by filing a Petition under 37 C.F.R. §1.182, which appears must be decided by the Office of the Deputy Commissioner for Patent Examination Policy. MPEP §1002.02(b).11. To avoid a possible judicially recognized "unhappy circumstance", as well as to avoid delay of Office processing of the application and imposition of added burden on the Office of the Deputy Commissioner for Patent Examination Policy, abeyance of the double-patenting rejections appears appropriate. Further, it is suggested that if, by way of this paper or otherwise, the claims are otherwise allowable but for the obviousness-type double patenting rejection, that the Examiner simply telephone the undersigned so that a Terminal Disclaimer may be promptly filed.

Claim 29 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,177,931 (Alexander et al.) in view of U.S. Patent No. 6,934,963 (Reynolds et al.).

The Office action states that "it would have been obvious for one of ordinary skill in the art to modify the monitoring device of Alexander using the internet access of Reynolds for the purpose of providing a hybrid passive-interactive television program guide system in which passive electronic television program guide content is integrated with an interactive television program guide (column 1, lines 64-67 and column 2, lines 1-6, Reynolds)." Office action, p. 14.

Reynolds provides "a hybrid passive-interactive television program guide system in which passive electronic television program guide content is integrated with an interactive television program guide. Information on the content of the passive electronic television program guide is provided to the interactive television program guide, so that the features on the interactive television program guide may be coordinated with the passive guide content. Reynolds et al., col. 1, line 66 - col.2, line 6. Reynolds also notes that "with interactive guides, however, there is generally no way to provide centrally-controlled promotional media such as

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promotional videos to users for display by the program guide while the users are viewing program listings." Reynolds et al., col. 1, lines 40-44.

Alexander et al., however, appears to provide a television program guide system in which passive electronic television program guide content is incorporated with an interactive television program guide. Alexander et al. is to an improvement over previous electronic program guides. Alexander, et al., Abstract. As indicated in Alexander et al., "Alternatively, the EPG provides the producers of infomercials with the opportunity to provide the viewer with the opportunity to view a video clip about the product being advertised. In one embodiment, the video clip associated with the product and/or program displayed in the Ad window is shown when the viewer highlights the Ad window. Depending upon the embodiment and/or viewer option selections, the video clip is shown in the PIP window, in the Ad Window, or full screen." Alexander et al., col. 19, line 67 - col. 20, line 8.

Accordingly, there appears to be no reason to modify Alexander et al. using Reynolds et al. for the purpose stated in the Office action. "The strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination. *In re Sernaker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983)." MPEP § 2144. The Office action points to no advantage or expected beneficial result in the combination of Alexander et al. and Reynolds et al. that is not already provided by Alexander et al. Thus, the combination of Alexander et al. and Reynolds et al. specified in the Office action is improper, and claim 29 and its dependent claims are allowable in view of Alexander et al. and Reynolds et al.

Moreover, claim 29 specifies "an integral unit for measuring viewer behavior related to television content...comprising: a monitoring device...monitoring an event data generated upon occurrence of an event to ascertain the responses of a viewer to program and advertising content...wherein the programming and advertising content is transmitted to the television with an Internet access signal." The Office action states that Alexander et al. "fails to teach wherein

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the programming and advertising content is transmitted to the television with an internet access signal." Office action, p. 13.

The Office action points to col. 9, lines 40-57, figure 2a, and figure 4 of Reynolds for teaching distributing television programming over the Internet. Office action, p. 14. Figure 2a of Reynolds shows a distribution facility 16 coupled by a communication pathway 20 to user television equipment 22. Reynolds et al. states that "communications path 20 may be any communications path or paths suitable for distributing programmed guide data. Communications path 20 may include, for example, a satellite link, a telephone network link, a cable or fiber optic link, a microwave link, an internet link, a data-over-cable service interface specification (DOCSIS) link, a combination of such links, or any other suitable communications link. Communications path 20 preferably has sufficient bandwidth to allow distribution facility 16 to distribute television programming to user television equipment 22...If desired, television programming may be provided over separate communications paths (not shown)." Reynolds, et al., col. 9, lines 41-57.

The context of Reynolds et al., however, indicates that television programming is not provided over an Internet link to the user equipment. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)." MPEP § 2141.02 VI. As indicated in Reynolds, "during normal television viewing, a user tunes set-top box 28 to a desired television channel. The signal for that television channel is then provided at video output 30." Reynolds et al., col. 12, lines 35-40. Similarly, Reynolds et al. states that "to watch television, a user instructs control circuitry 42 to display a desired television channel on display device 45." Reynolds et al., col. 14, lines 50-52. Thus, while Reynolds et al. may discuss preferred bandwidth of a link by which program guide data is distributed to a user television equipment, it does not appear that Reynolds et al. discloses "an integral unit for measuring viewer behavior related to television content...comprising: a monitoring device...monitoring an event data generated upon occurrence of an event to ascertain the responses of a viewer to program and advertising content...wherein

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the programming and advertising content is transmitted to the television with an internet access signal" as specified in claim 29. Claim 29 and its dependent claims are therefore still further allowable.

Claim 49, like claim 29, also specifies "an integral unit for measuring viewer behavior related to television content...comprising: a monitoring device...monitoring an event data generated upon occurrence of an event to ascertain the responses of a viewer to program and advertising content...wherein the programming and advertising content is transmitted to the television with an Internet access signal." Accordingly, considering the discussion above, claim 49 is allowable.

Claim 50, like claim 29, also specifies "an integral unit for measuring viewer behavior related to television content...comprising: a monitoring device...monitoring an event data generated upon occurrence of an event to ascertain the responses of a viewer to program and advertising content...wherein the programming and advertising content is transmitted to the television with an Internet access signal." Accordingly, considering the discussion above, claim 50 is allowable.

Claim 51 specifies "a set top box for measuring viewer behavior related to television content...comprising: a monitoring device...monitoring an event data generated upon occurrence of an event to ascertain the responses of a viewer to program and advertising content...wherein the programming and advertising content is transmitted to the television with an Internet access signal." Accordingly, considering the discussion above, claim 51 and its dependent claims are allowable.

Claim 67 specifies "a cable box for measuring viewer behavior related to television content...comprising: a monitoring device...monitoring an event data generated upon occurrence of an event to ascertain the responses of a viewer to program and advertising content...wherein the programming and advertising content is transmitted to the television with an internet access signal." Accordingly, considering the discussion above, claim 67 and its dependent claims are allowable.

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New claims 83-88 are added by this paper. Support for new claims 83-88 may be found, for example, in the application as filed in Figs. 1 and 2, and in the text at pages 6-10, 19, and 21-25.

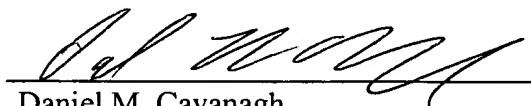
In addition, the application claims priority of U.S. Patent Application No. 08/975,374, filed November 20, 1997, now U.S. Patent 6,286,140. Support for new claims 83-88 may be found in the priority application, for example, in Figs. 1 and 2, and in the text at pages 2-6, 13, and 15-19. At least claims 83-88, therefore, are entitled to an effective filing date of November 20, 1997.

Alexander et al. was filed July 21, 1998. Reynolds et al. was filed September 21, 1999. Accordingly, neither Alexander et al. nor Reynolds et al. are prior art to at least claims 83-88.

New claims 83-88 are therefore allowable, and allowance of same is respectfully requested.

In addition, as the application as a whole is in condition for allowance, allowance of the application is also respectfully requested.

Respectfully submitted,
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